

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 13

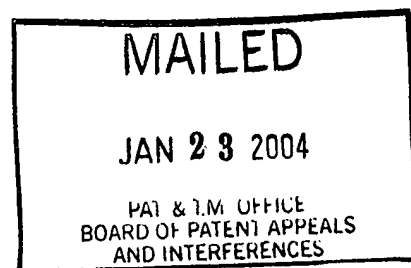
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LORNA B. VOIT

Appeal No. 2004-0269
Application No. 09/589,866

ON BRIEF



Before COHEN, FRANKFORT and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4, 5
and 7-17, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a collection of portable key ring tags each bearing a vocabulary word on one side thereof and the definition of the vocabulary word on the other side thereof for use in combination with a key ring having at least one key retained thereon. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

| | | |
|---------|-----------|--------------|
| Peckham | 335,837 | Feb. 9, 1886 |
| Luciano | 6,101,367 | Aug. 8, 2000 |

The following is the sole rejection before us for review.

Claims 1, 4, 5 and 7-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Peckham in view of Luciano.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection and answer (Paper Nos. 5 and 8) for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 7 and 9) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Each of appellant's independent claims 1, 7 and 11 requires a key, a key ring and at least one tag, with the tag having disposed thereon a challenge (such as a word, as recited in claims 7 and 11) and an answer appropriate to the challenge (such as a definition of said word as recited in claims 7 and 11). Claim 1 recites that the answer is normally concealed when the challenge is visible and claims 7 and 11 call for the word and definition to be disposed on opposite surfaces of the tag.

Peckham discloses an educational device comprising a plurality of disks or tablets A strung upon a rod or wire B, the ends of which rod or wire may be joined together to form a ring. Each disk is imprinted upon one face with a query in the form of a character, letter, word or problem and upon its opposite face with a reply to said query. As conceded by the examiner, Peckham lacks a key ring and a key attached to the key ring as called for in appellant's claims.

Luciano discloses a question-answer book having pages with question text 16 printed thereon and microprocessor chips 17 secured to the marginal edge portions 18 of the pages adapted to be read by a handheld reader 11, as illustrated in Figures 2

and 3. The reader 11 is provided with a reader slot which makes the reader positionable over or relative to the chips 17 for reading the chips and displaying information for each associated page on its digital display. Luciano discloses that the "reader 11 is provided with a conventional key chain attachment 22 for storage securement to the book or elsewhere for storage" (column 2, lines 44-46).

According to the examiner (final rejection, pages 2-3),

[a]lthough Luciano did not show a key actually attach[ed] to the key chain, it is inherent that a key chain typically includes a key. Therefore, it would have been obvious to one of ordinary skill in the art to modify the educational device of Peckham with teaching of providing an educational device attached to a key chain or ring as taught by Luciano for the purpose of allowing the user to conveniently carry the device around.

At the outset, we do not share the examiner's view (answer, pages 3-4) that Luciano's use of the terminology "a conventional key chain attachment 22" clearly indicates a desire for the reader 11 to be attached with keys. Luciano makes it clear in column 2, lines 44-46, that the purpose of the key chain attachment 22 is for securement to the book or elsewhere for storage. The terminology "conventional key chain attachment" is merely intended to describe the structure of the attachment device in terms with which one skilled in the art reading the patent would be expected to be familiar. Luciano in no way teaches or suggests attachment of a key to the key chain attachment attached to the reader 11.

In any event, even assuming Luciano were interpreted as teaching or suggesting attachment of a key to the key chain attachment 22, it is not apparent to us how the combined teachings of Peckham and Luciano would have motivated one of ordinary skill in the art to modify Peckham to arrive at the claimed subject matter. At best, Luciano might have suggested modification of Peckham's disks to provide thereon a query and a microchip programmed with an appropriate response to the query and the use of a reader, such as Luciano's microchip reader 11, with the educational device of Peckham to read and display the answer programmed into the microchip. This would not result in appellant's claimed invention.

For the foregoing reasons, we conclude that the combined teachings of Peckham and Luciano are insufficient to have suggested the subject matter of appellant's independent claims 1, 7 and 11. Thus, we cannot sustain the examiner's rejection of these claims or claims 4, 5, 8-10 and 12-17 depending therefrom.

REMAND TO THE EXAMINER

Pursuant to our authority under 37 CFR § 1.196(a), we remand this application to the examiner for consideration of the following and appropriate action with respect thereto.

Appellant's claim 1 recites a key ring with a key and an attached tag, the tag presenting an educational challenge displayed on a first surface and an answer appropriate to the challenge which is normally concealed when the challenge is visible,

such as an answer displayed on the opposite surface of the tag. This claim, unlike independent claims 7 and 11, is not limited to a tag having a vocabulary word on one side and the definition thereof on the opposite side and would appear to be met by a tag, on a key ring with a key, having different but associated displays, which may take the form of text, numbers, pictures, etc., on opposite sides thereof.¹ Accordingly, a search in at least class D3, subclasses 207 and 208, would appear to be appropriate. As the search notes on the file wrapper of this application do not indicate that a search was conducted in this area, this application is remanded to the examiner to conduct such a search and to consider other appropriate prior art of which the examiner may be aware in light of the above remarks with regard to the scope of claim 1.

¹ For example, a souvenir-type key ring tag having the name of a city on one side and text or pictures descriptive of that city on the other side would fall within the claimed subject matter.

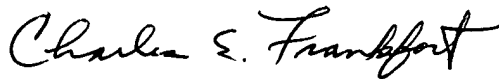
CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 4 and 7-17 under 35 U.S.C. § 103 is reversed and the application is remanded for the reason discussed above.

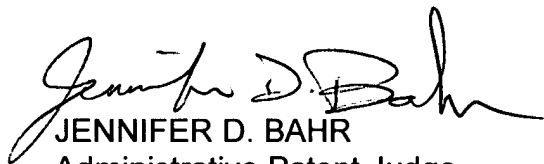
REVERSED AND REMANDED



IRWIN CHARLES COHEN
Administrative Patent Judge



CHARLES E. FRANKFORT
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2004-0269
Application No. 09/589,866

Page 8

ALBERT W. WATKINS
30844 NE 1ST AVENUE
ST. JOSEPH, MN 56374